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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/098,700	03/15/2002	David W. Cunningham	4000-007	6945

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EXAMINER

GLASS, RUSSELL S

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/098,700	Applicant(s) CUNNINGHAM ET AL.	
	Examiner Russell S. Glass	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-19, 54 and 55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-19, 54 and 55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 15-19, 54 and 55 in the reply filed on July 13, 2006 is acknowledged.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. **Claims 15-19, 54, and 55 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-30 of (U.S. 5,832,449) in view of Deaton et al., (U.S. 5,644,723).**

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: issuing media, identifying media with an identifier stored in a central database, associating the media with a good or service, activating and/or deactivating the status of the media, varying the value of the media, distributing the media, and presenting the media for redemption of goods or services. Although the '449 patent is directed specifically toward pharmaceutical goods and services, this subject matter falls within the broad scope of the claims presented in the present application that are directed toward unspecified goods and services. Therefore, the subject matter of the present application is considered to be obvious in view of the '449 patent.

Furthermore, Deaton further discloses the well-known method of issuing active and inactive media, and activating the media and recording the change of the status in the database, (Deaton, Fig. 6A, col. 5, lines 9-24; col. 31, lines 60-66).

It would have been obvious to one of ordinary skill in the art to combine U.S. 5,832,449 and Deaton. The motivation would have been to issue incentive coupons based upon said activation signal, (Deaton, abstract).

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section

Art Unit: 3626

351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 15-19, 54, 55 are rejected under 35 U.S.C. 102(e) as being anticipated by Deaton et al., (U.S. 5,644,723).

4. As per claim 15, Deaton discloses a method of promoting goods and services, comprising:

issuing media in which each medium has at least one good or service associated therewith, (Deaton, col. 70, lines 8-27);

identifying each medium with an identifier and recording the identifier in a database such that the at least one good or service associated with each medium can be determined, (Deaton, col. 4, lines 44-47);

assigning an inactive status to the media such that while assuming the inactive status the goods or services associated with the medium may not be redeemed, (Deaton, Fig. 6A, col. 31, lines 60-66);

recording the inactive status in a database, (Deaton, Fig. 6A, col. 5, lines 9-24; col. 31, lines 60-66);

activating at least some of the media by changing the status of the media from an inactive state to an active state and recording the change of the status in the database, (Deaton, Fig. 6A, col. 5, lines 9-24; col. 31, lines 60-66);

varying the value of at least some of the media such that the value of the media varies according to selected conditions, (Deaton, col. 106, lines 25-54); and

distributing the media to holders wherein the holders present the media to providers that deliver the goods or services associated with the presented media to the holders, (Deaton, col. 7, lines 11-31).

5. As per claim 16, Deaton discloses a method of claim 15 including varying the value of the media based on the manner of activation, the location of the provider, or the identity of the holder or provider, (Deaton, col. 4, lines 44-46; col. 106, lines 25-54).

6. As per claim 17, Deaton discloses a method of claim 15 wherein the database is consulted at various times to determine whether the media or a certain medium is active or inactive, (Deaton, Fig. 6A, col. 5, lines 9-24; col. 31, lines 60-66).

7. As per claim 18, Deaton discloses a method of claim 15 wherein the database is updated from time to time with respect to the status of a medium and the value associated with the medium, (Deaton, col. 5, lines 9-24; col. 31, line 60-col. 32, line 36).

8. As per claim 19, Deaton discloses a method of claim 18 including the provider communicatively linking to the database and determining whether a presented medium is active or inactive, and further communicating for recordation in the database any goods or services delivered to a holder as a result of the medium being presented to the

provider, (Deaton, col. 5, lines 9-24; col. 31, line 60-col. 32, line 36; col. 67, line 50-col. 70, line 39).

9. As per claim 54, Deaton discloses a method of promoting goods or services, comprising:

provisioning a database by:

(a) assigning a unique identifier to a medium wherein the medium forms a part of a media, (Deaton, col. 4, lines 44-47).

(b) associating a good or service with each medium, (Deaton, col. 70, lines 8-27);

(c) linking the good or service associated with each medium with the unique identifier of that medium, (Deaton, col. 7, lines 12-31, col. 70, lines 8-27).

distributing the media to individuals that enable the individuals to present the media to providers of goods or services who under certain circumstances will redeem the presented media by delivering to the individuals one or more goods or services associated with the media, (Deaton, col. 70, lines 8-27);

activating the media by changing the status of the media from an inactive state to an active state and recording that status change in a database, (Deaton, Fig. 6A, col. 5, lines 9-24; col. 31, lines 60-66);

the individuals receiving the media, presenting the media to providers of goods or services associated with the media, (Deaton, col. 7, lines 12-31),

determining the status of the media presented by communicating with the database, (Deaton, Fig. 6A; col. 31, lines 60-66);

delivering one or more goods or services associated with the media to individuals presenting an active medium, (Deaton, col. 31, lines 60-66; col. 70, lines 44-64), and

the providers communicating with the database to indicate that one or more goods or services associated with particular media has been delivered to individuals presenting certain media to the providers, and wherein the database is updated to reflect the transfer of one or more goods or services from the providers such that the database will generally reflect media that has been presented to providers and the goods or services delivered by the providers in response to the presentment of the media, (Deaton, col. 70, lines 44-64)

wherein the database is provisioned with certain criteria that establishes variable value for the media, (Deaton, col. 106, lines 25-54).

10. As per claim 55, Deaton discloses a method of claim 54 wherein the value of the media is a function of the manner in which the media is activated, the location of the provider, the identity of the provider, or the identity of the individuals presenting the media, (Deaton, col. 4, lines 44-46; col. 106, lines 25-54).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell S. Glass whose telephone number is 571-272-3132. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RSG
7/21/2006



JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER